

REMARKS

Claims 1-12, 14, 15 and 18-21 are pending in this application. Claims 1-11 are withdrawn from consideration as being drawn to a non-elected Group. Rejoinder of claims 1-12, 14, 15 and 18-21 is respectfully requested.

By this Amendment, claims 13, 16 and 17 are cancelled without prejudice to or disclaimer of the subject matter contained therein, claim 12 is amended, and claims 18-21 are added. No new matter is added by any of these amendments.

Applicants appreciate the courtesies extended to Applicants' representative by Examiner Gray during the May 6, 2003 telephone interview. In accordance with MPEP §713.04, the points discussed during the interview are incorporated in the remarks below and constitute Applicants' record of the interview.

Applicants gratefully acknowledge that the Office Action indicates that the specification discloses allowable subject matter.

Reconsideration based on the following remarks is respectfully requested.

**I. Amendment Entry after Final Rejection**

Entry of this submission is proper under 37 CFR §1.114 because the amendments are submitted with a Request for Continued Examination. Accordingly, entry of this Submission is appropriate under §1.114 and respectfully requested.

**II. Claims 12, 14, 15 and 18-21 Define Patentable Subject Matter**

The Final Office Action rejects claims 12, 14 and 15 under 35 U.S.C. §103(a) over Japanese Patent JP 2726856 B2 to Kondo *et al.* (Kondo) in view of U.S. Patent 5,620,544 to Cram *et al.* (Cram). This rejection is respectfully traversed.

Applicants assert that neither Kondo nor Cram teaches or suggests an adhesive film printed on a desired item on a surface of the adhesive film beforehand, as recited in claim 12. Applicants' claims are directed to an unprinted adhesive film arranged and then printed with a desired item on a surface of the adhesive followed by sticking on a surface of a main film,

not that of an adhesive film printed beforehand. Therefore, Applicants' claimed features provide for printing an adhesive film indicating an item changed depending on various kinds of main tape, winding amount, shipping identifications, etc. on its surface, and stuck on a surface of a main film without exchanging adhesive tapes.

The Final Office Action further rejects claim 13 under 35 U.S.C. §103(a) over Kondo in view of Cram and further in view of Japanese Patent Application 9-226197 A to Tabuchi. This rejection is rendered moot by the cancellation of claim 13.

The Final Office Action further rejects claims 12-17 under 35 U.S.C. §103(a) over U.S. Patent 4,339,294 to Jones in view of Cram. This rejection is rendered moot with respect to claims 13, 16 and 17 and is respectfully traversed with respect to claims 12, 14 and 15.

Applicants assert that neither Jones nor Cram teaches or suggests an adhesive film printed on a desired item on a surface of the adhesive film beforehand, as recited in claim 12. Applicants' claims are directed to an unprinted adhesive film arranged and then printed with a desired item on a surface of the adhesive followed by being stuck on a surface of a main film, not that of an adhesive film printed beforehand.

Therefore, Applicants' claimed features provide for printing an adhesive film indicating an item changed depending on various kinds of main tape, winding amount, shipping identifications, etc. on its surface, and stuck on a surface of a main film without exchanging adhesive tapes.

*A prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teachings, a reasonable expectation of success, and the references must teach or suggest all the claim limitations. See MPEP §706.02(j). Applicants respectfully assert that the Final Office Action has not satisfied this burden, either with the combination of Kondo and Cram or with the combination of Jones and Cram.

For at least these reasons, Applicants respectfully assert that the independent claim is now patentable over the applied references. The dependent claims are likewise patentable over the applied references for at least the reasons discussed as well as for the additional features they recite. Consequently, all the claims are in condition for allowance. Thus, Applicants respectfully request that the rejections under 35 U.S.C. §103 be withdrawn.

**III. Conclusion**

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:GWT/gwt

Attachment:  
Petition for Extension of Time

Date: November 14, 2003

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